

C. Remarks

At page 2 of the Office Action, the Office states that Applicant's arguments filed October 2, 2008 regarding the non-obviousness of claims 1, 3-7, 9, 10 and 30-34 were persuasive, and that the 35 U.S.C. § 103 rejections presented in the Office Action dated May 13, 2008 have been consequently withdrawn. No new rejections under 35 U.S.C. § 102 or § 103 are presented in the Office Action. At pages 3-4 of the Office Action, claims 1, 3-7, 9, 10 and 30-34 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. At page 4 of the Office Action, claim 30 is additionally rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant traverses the rejections as follows.

Extension of Time

Applicant encloses herewith a petition under 37 CFR 1.136(a) to extend the time period for submitting the present response by three (3) months. The Office is hereby authorized to charge the fee set forth under 37 CFR 1.17(a)(3), large entity, in connection with this petition, as well as any other fees necessary for consideration of this submission, to Deposit Account No. 11-1110.

Examiner Interview

Applicant's undersigned representative conducted an interview in connection with the Office Action with Examiners Rankins and Felten on February 4, 2009. During the interview, Applicant's representative proposed amendments to address the 35 U.S.C. § 101 rejections presented in the Office Action. A copy of the proposed amendments

communicated to the Examiners prior to the interview is attached at Appendix A hereto. The Examiners stated that the proposed amendments appeared to address the § 101 rejections. The Examiners also stated in connection with the proposed amendments that it was not clear how the “correlation” of proposed claim 1 was related to the remainder of the claimed subject matter. The Examiners also stated that they did not regard the “agreement” recited in proposed claim 1 as constituting patent-eligible subject matter. No agreement regarding the patentability of any claim was reached during the interview.

Claim Amendments

As amended, claim 1 recites, *inter alia*,

determining, using a computer, for each of at least one private issuer of fixed income securities, a correlation between inflation and a likelihood that the private issuer will default on the fixed income securities, wherein the computer comprises a processor and a memory;

and

selecting one of the at least one private issuer based on the correlation determined for each of the at least one private issuer.

Support for this amendment is found, for example, at paragraph [0019] of the specification as filed. Claims 5 and 6 have been amended in consequence of the amendment to claim 1. No new matter is introduced by these claim amendments.

Claims 30-34 have been canceled.

35 U.S.C. § 101 Rejections

Claims 1, 3-7, 9, 10 and 30-34 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

A process claim satisfies § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008). Whether or not selected limitations of a claim constitute patent-eligible subject matter is not determinative of the patent eligibility of a claim as a whole. *Id.* at 958 (noting that “even though a fundamental principle itself is not patent-eligible, processes incorporating a fundamental principle may be patent-eligible”). Accordingly, otherwise patent-eligible processes are not deprived of patent-eligibility merely because an individual step or limitation of such processes would be unpatentable under § 101 if considered alone.

At pages 3-4 of the Office Action, the grounds cited by the Office for the § 101 rejection of claim 1 are that (1) the claims are not tied to another statutory class, and (2) claims 1 and 30 comprises an agreement, and that “[c]ontracts, deals, agreements and the like are not statutory subject matter as they are neither processes, articles of manufacture, an apparatus nor compositions of matter.”

With respect to the first ground of the § 101 rejection cited by the Office, the proper inquiry for assessing patent eligibility of a process claim, as set forth in *Bilski*, focuses on whether the claim is tied to a particular machine or apparatus, or whether the claim transforms a particular article into a different state or thing. Applicant submits that amended claim 1 is directed to patentable subject matter under § 101 because it is

ties to a machine, namely a computer including a processor and a memory, which is one of the statutory classes listed in § 101. In *In re Nuijten*, the Federal Circuit stated:

The Supreme Court has defined the term “machine” as “a concrete thing, consisting of parts, or of certain devices and combination of devices.” *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863). This “includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result.” *Corning v. Burden*, 56 U.S. 252, 267 (1854).

In re Nuijten, 500 F.3d 1346, 1355 (Fed. Cir. 2007).

Because a “computer, ... wherein the computer comprises a processor and a memory,” as recited in claim 1, is “a concrete thing, consisting of parts, or of certain devices and combination of devices,” Applicant submits that claim 1 and its dependent claims recite patent eligible subject matter under § 101.

With respect to the second ground of the § 101 rejection cited by the Office, the Office is incorrect that claim 1 as a whole is not patent eligible because one feature of claim 1 is allegedly not patent eligible. As clearly set forth in *Bilski*, patent eligibility is not properly based on a single selected claim limitation, and otherwise patent-eligible process claims may well include limitations that would not be patent eligible if considered alone. Accordingly, the Office’s reasoning that the process of claim 1 is not patent eligible merely because a single feature of claim 1 by itself is allegedly not patent eligible is wrong. As noted above, the process of claim 1 is tied to a particular machine, and that alone is sufficient to satisfy the patent eligibility requirements of § 101. It is irrelevant for purposes of analysis under § 101 that another step of claim 1, if considered alone, would not be patent eligible.

Accordingly, Applicant submits that amended claim 1 and dependent claims 3-7, 9 and 10 recite patent eligible subject matter under § 101. As claims 30-34 have been canceled, the § 101 rejections of these claims are rendered moot.

35 U.S.C. § 112, Second Paragraph Rejection

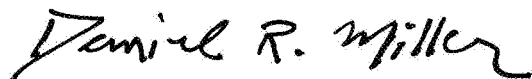
Claim 30 has been canceled, thus rendering the § 112, second paragraph rejection of this claim moot.

D. Conclusion

The above-described amendments have been made for purposes of expediting prosecution; the correctness of any rejection of the present or preceding Office Actions is not conceded. Applicant reserves the right to present arguments as may be necessary because features of dependent claims further distinguish the independent claims from the cited references. A detailed discussion of such differences is believed to be unnecessary at this time in view of at least the differences between the independent claims and the cited reference discussed above.

Applicant respectfully requests a Notice of Allowance for the pending claims in the present application. If the Examiner is of the opinion that the present application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,



Daniel R. Miller
Reg. No. 52,030

K&L Gates LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222
Telephone: (412) 355-6773
Facsimile: (412) 355-6501
E-mail: daniel.miller@klgates.com